

R E M A R K S

Reconsideration of the present application, as amended, is respectfully requested.

The April 29, 2002 Office Action and the Examiner's comments have been carefully considered. In response, a telephonic interview was conducted with the Examiner, claims are amended and remarks are set forth below in a sincere effort to place the present application in form for allowance. The amendments are supported by the application as originally filed. Therefore, no new matter is added.

INTERVIEW

The courtesy of Examiner Basinger in granting a telephonic interview in connection with this application is acknowledged and appreciated. During the interview, applicant's attorney, Robert Michal, discussed the present claimed invention and the cited references with Examiner Basinger. Applicant's attorney pointed out that claim 18 is patentable over the combination of references because the references do not disclose the claimed subject matter and because the secondary reference is non-analogous art as compared to the present invention and not properly combinable with the primary reference. It was also pointed out that the references do not teach the limitations set forth in claim 9 and that the rescue device of the present invention is distinguishable over the cited references in that

the rescue device is flexible and that first and second ends of the rescue device can be disposed proximate each other to at least partially encircle at least a portion of the body of a person in the water to support the person in the water.

Applicant's attorney also pointed out that the present claimed invention is distinguishable over the main reference (Robinson) in that the claimed invention is directed to a personal floatation device to be worn or encircled around a user while floating in water (a rescue tube typically used by a lifeguard, a life vest, a life saving can, a life preserver, noodle or floating ring), while Robinson is directed to a boat. The Examiner agreed that the present invention is distinguishable over the cited references but stated that the claims should be further amended to more clearly point out the patentable features.

REJECTION UNDER 35 USC 112

In the Office Action claim 16 is rejected under the second paragraph of 35 USC 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner states that the term "the rescue tube" has no clear antecedent basis in claim 16. In response, claim 16 is amended to change the term "rescue tube" to --rescue device--. In view

of the amendment of claim 16, reconsideration and withdrawal of the rejection of claim 16 are respectfully requested.

PRIOR ART REJECTIONS

In the Office Action claims 1-5, 15 and 21 are rejected under 35 USC 103 as being unpatentable over USP 5,617,808 (Robinson). Claims 6-14, 16, 17, 19, 20 and 22-26 are rejected under 35 USC 103 as being unpatentable over Robinson in view of USP 6,257,163 (Carpenter). Claim 18 is rejected under 35 USC 103 as being unpatentable over Robinson in view of USP 5,851,339 (Rucker).

In response, claim 1 is amended to recite that the rescue device is sufficiently flexible and includes first and second ends, wherein the first and second ends of the rescue device can be disposed proximate each other to at least partially encircle at least a portion of the body of a person in the water to support the person in the water. Support for this amendment can be found at page 6, lines 6-9, inter alia, of the present application. As pointed out by applicant's attorney to Examiner Basinger during the interview, USP 5,617,808 to Robinson discloses that the solid foam element 1 is rigid and inflexible. In fact, Robinson teaches that the solid foam element 1 includes a reinforcement rod 4 which may be fabricated of wood, metal or a viscoelastic material such as PVC running through the

longitudinal center of the foam core (see Col. 3, lines 1-5 of Robinson). Based on this teaching in Robinson, it is clear that the foam element 1 of Robinson is inflexible and does not meet the claim limitations.

In view of the foregoing, claim 1 and claims 2-5 and 15 which are dependent thereon are patentable over Robinson under 35 USC 102 as well as 35 USC 103.

Claims 2-14 and 16-20 which are dependent on claim 1 are patentable over the cited references in view of their dependence on claim 1.

Claim 21 is amended to recite that the floatation device is one of a life saving rescue tube employed by a lifeguard, a life vest, a life saving can, a life preserver, a noodle and a floating ring and that the floatation material is flexible. Support for this limitation can be found at page 10, lines 12-15, inter alia, of the present application. Claim 21 is patentable over Robinson because Robinson does not disclose a flexible flotation material and because Robinson is not directed to a life saving rescue tube typically employed by lifeguards, a life vest, a life saving can, a life preserver, a noodle or a floating ring.

Claim 22 recites that the rescue device includes a towline having first and second ends and a length, the first end of the towline being coupled to one end of the rescue device, and the

flexible mesh being directly secured to the towline. In rejecting claim 22 the Examiner states that "the flexible mesh would be secured to the towline through the hardware attaching the towline to the boat of Robinson". Robinson does not, however, disclose, teach or suggest that the flexible mesh is directly coupled to the towline as recited in amended claim 22. Carpenter et al teach that a cleat or other attachment device (see Fig. 1 of Carpenter) which is directly secured to the boat is utilized as an intermediary for coupling the utility tether apparatus 100 to the boat 110. As a result neither Robinson nor Carpenter when taken either alone or in combination disclose, teach or suggest that the flexible mesh which is disposed entirely about the floatation material is directly secured to the towline. In view of the foregoing, claim 22 is patentable over Robinson and Carpenter under 35 USC 102 as well as 35 USC 103.

Claim 23 is amended to include the limitation which was added to claim 1. Claim 23 is patentable over the cited references for reasons, inter alia, set forth above in connection with claim 1.

Claims 24-26 which are dependent on claim 23 are patentable in view of their dependence on claim 23.

With regard to claim 18, the Examiner rejects this claim as being unpatentable over Robinson in view of Rucker.

Applicant respectfully states that Robinson and Rucker are not properly combinable and therefore it would not have been obvious for a person of ordinary skill in the art at the time the invention was made to look at such diverse fields of application as covered by Robinson (portable foam tube boat with flexible shell) and Rucker (method of making a laminated product such as a mattress and furniture insulator pad) to arrive at a solution to a problem not suggested by any one of the references. Even further, there is no motivation to combine the references in the manner asserted by the Examiner. Therefore the rejection is improper and must fail.

An Examiner cannot arbitrarily pick and choose elements from the prior art in a piecemeal fashion to construct the claimed invention, without some direction from the prior art. In re Donovan and Ryan, 184 U.S.P.Q. 414, 420 (C.C.P.A. 1971). It appears, however, that this is exactly what the Examiner has done. It is respectfully submitted that combining the references as suggested by the Examiner could only result from impermissible hindsight gained by utilizing applicant's own disclosure to construct the present invention from bits and pieces of the prior art. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 312-313 (C.A.F.C. 1983); In re McLaughlin, 170 U.S.P.Q. 209 (C.C.P.A. 1971).

As succinctly stated by the Board of Appeals:

In our view the here claimed subject matter would not have been obvious within the meaning of 35 U.S.C. 103 based solely on the Baney Patent. As correctly urged by the appellant, and as apparently recognized by the Examiner, in order to meet the terms of the claims on appeal, the elements of the Baney device would have to be arranged in a manner different from that disclosed by Baney. The elements of the reference would also be required to coact differently from the way they coact in the arrangement disclosed by the reference. The mere fact that a worker in the art could rearrange the part of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of the appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the Baney device to render the here claimed device unpatentable. We additionally note that the interrelationship and the relative movements of the various elements required by the claims on appeal would not be met by the Baney device even if reconstructed as suggested by the Examiner. Ex parte Chicago Rawhide Manufacturing Co., 223 U.S.P.Q. 351, 353 (Bd. Pat. App. 1984). (Emphasis added)

In this regard, it has been held that, in considering the prior art references, the relevant consideration is what these references, when considered together, make obvious to one of ordinary skill in the art. In re Mapelsdon, 141 U.S.P.Q. 30, 32 (C.C.P.A. 1971). There is no disclosure or suggestion to modify Robinson to arrive at the present claimed invention.

"Modification unwarranted by the disclosure of a reference is improper." Carl Schenck A.G. v Nortron Corporation, 218 U.S.P.Q. 698, 702 (C.A.F.C. 1983). The Examiner's failure to indicate

anywhere in the record any reason or basis for altering of the reference militates against the rejection. Ex parte Kaiser, 194 U.S.P.Q. 47 (Bd. Pat. App. 1975).

It is not the mere possibility of combining the references that must be taken into consideration, but rather there must exist some logical reason or some suggestion in the art for combining the references. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983); ACS Hospital Systems, Inc. v. Montefiore Hospital et al.; 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984); In re Imperato, 179 U.S.P.Q. 730, 732 (C.C.P.A. 1973). The Examiner has not disclosed any valid reason to combine the references and there certainly is no logical reason to do so.

Not only do the cited references fail to disclose or suggest the claimed invention, but they also fail to disclose or suggest the problems which required the applicants to arrive at the present invention. As the Court of Customs and Patent Appeals stated in In Re Sponnoble, 160 U.S.P.Q. 237, 243 (C.C.P.A. 1969):

A patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 USC 103 (cases cited). The Court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statement; that is we must view the prior art without reading into that art applicant's teaching (cases cited). The issue, then, is whether the

teachings of the prior art, in and of themselves and without the benefit of applicant's disclosure, make the invention as a whole, obvious.

The shortcomings of prior art which are overcome by the present invention were not even contemplated by the cited references. Therefore, the claimed invention must be patentable thereover.

Even if the cited references are properly combinable, their disclosure does not teach or suggest the limitation recited in claim 18. That is, Rucker does not disclose, teach or suggest that the bonding material has a thickness such that the flexible mesh provides texture to the surface of the rescue device. Rucker teaches that a core foam center sheet 16 is applied to stiffening layers 14 and 20. The stiffening layers are secured to the core foam center sheet by a hot melt adhesive film 32 positioned adjacent or applied to the top surface 12 of the core foam center sheet 16. In contrast to the present claimed invention wherein the bonding material is applied to the flexible mesh, Rucker teaches that a thin foam sheet 22 is applied over the surface of the stiffening layers 14, 20. Rucker does not teach the benefit nor address the problem overcome by the present claimed invention as defined by claim 18 which provides a better gripping surface for the rescue device which is to be held and manipulated while wet.

In view of the foregoing, claim 18 is separately patentable over the cited references under 35 USC 102 as well as 35 USC 103.

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If the Examiner disagrees with any of the foregoing, the Examiner is respectfully requested to point out where there is support for a contrary view.

Entry of the amendment, allowance of the claims, and the passing of the application to issue are respectfully solicited.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

Respectfully submitted,



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Enc. - Copy of amended claims showing changes made thereto